

DOCKET NO.: PH-7124 US (BMS-2293)
Application No.: 10/033,770
Office Action Dated: September 16, 2003

PATENT

REMARKS/ARGUMENTS

Claims 1 to 60 are pending in this application. Claims 7 to 42 and 44 to 60 are withdrawn from consideration. Claims 1 to 4 and 43 are rejected. Claims 5 and 6 are objected to. Applicants are herein amending claims 1 to 5 and adding new claim 61.

Amendment to the Claims

Applicant is herein amending claims 1 to 5 and adding new claim 61:

- Applicant is herein amending the definition of R^2 in claim 1. Specifically, applicant is amending claim 1 to specify that R^2 is C_1 - C_{10} fluoroalkyl substituted with 0-5 R^7 , C_2 - C_{10} alkenyl substituted with 0-5 R^7 , C_2 - C_{10} fluoroalkenyl substituted with 0-5 R^7 , aryl substituted with 0-5 R^7 , heteroaryl substituted with 0-5 R^7 or fluoroaryl substituted with 0-5 R^7 .
 - Applicant is amending dependent claims 2 to 4 to make them consistent with and to properly depend from claim 1.
 - Applicant is herein amending claim 5 to present it as an independent claim.
 - Applicant is herein adding new claim 61 directed to pharmaceutical composition comprising the tripodal polyaminophosphonate chelant of newly independent claim 5.
- Applicant submits that no new matter is introduced by the amendments to the claims. Support for the amendment may be found, *inter alia*, in the claims, as originally filed.

Restriction Requirement

Applicant wishes to clarify that in his traversal of the restriction requirement he did not allege that the subject matter of the 65 groups were not distinct. Rather, applicant challenged the *prima facie* showing of a serious burden on the examiner to examine the

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application, as set forth in MPEP § 808.02. Further, applicant requested reconsideration and reduction of large number of groups (from 65 groups to 9 groups).

Rejection under 35 U.S.C. § 102(b)

In the office action, claims 1 to 4 and 43 are rejected under 35 U.S.C. § 102(b) over US-A-5,066,478. Applicant is herein amending claims 1 to 4 such that R² is selected from the group consisting of C₁-C₁₀ fluoroalkyl substituted with 0-5 R⁷, C₂-C₁₀ alkenyl substituted with 0-5 R⁷, C₂-C₁₀ fluoroalkenyl substituted with 0-5 R⁷, aryl substituted with 0-5 R⁷, heteroaryl substituted with 0-5 R⁷ and fluoroaryl substituted with 0-5 R⁷. Thus, as amended herein, R² defines chemical moieties that are different from the corresponding chemical moieties in the compounds disclosed in US-A-5,066,478. Applicant respectfully submits that US-A-5,066,478 does not disclose, teach, or suggest any tripodal polyaminophosphonate chelant where R² is defined as in claim 1 and its dependent claims and thus does not anticipate claims 1 to 4 and 43.

Accordingly, applicant respectfully requests withdrawal of the rejection of claims 1 to 4 and 43 under 35 U.S.C. § 102(b) over US-A-5,066,478.

Objection to Claims

In the office action, claims 5 and 6 are objected to as depending from a rejected base claim but would be otherwise allowable if written in independent form. Applicant is herein amending claim 5 to present it as an independent claim. Claim 6 depends from newly independent claim 5.

Accordingly, applicant respectfully requests withdrawal of the objection to claims 5 and 6.

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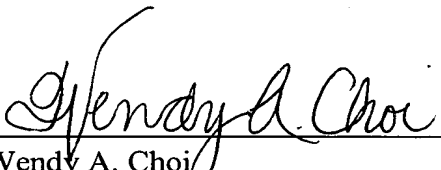
Conclusion

Applicant requests:

- (1) entry of the amendments to the claims;
- (2) reconsideration and withdrawal of the rejection of claims 1 to 4 and 43;
- (3) reconsideration and withdrawal of the objection to claims 5 and 6; and
- (4) allowance of claims 1 to 6, 43 and 61.

If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (215) 557-3861.

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